

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed March 21, 2005. At the time of the Office Action, Claims 1-4, 6-14, 16-24, 26-33, 35-43, and 45-67 were pending in the Application. Applicant amends Claims 51, 56, 62, and 65 and cancels Claims 52 and 57 without prejudice or disclaimer. Applicant's amendments and cancellations have been done in an effort to advance prosecution in this case and not to overcome prior art. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1-4, 6-7, 9-14, 16-17, 19-24, 26-27, 29-33, 35-36, 38-43, 45-46, and 48-67 under 35 U.S.C. §102(e), as being anticipated by U.S. Publication No. US 2002/0068565 A1 issued to Purnadi, et al. (hereinafter "*Purnadi*"). Applicant respectfully traverses this rejection.

As a preliminary matter, Applicant is both surprised and disappointed to discover that the Examiner has recanted his previous position with regard to the allowability of a number of claims. Applicant only made the previous amendments based on the Examiner's position and, moreover, in an effort to expedite prosecution in this case. Assuaging Applicant's concern is the somewhat irrelevant passage cited by the Examiner to now (ostensibly) anticipate the pending subject matter. Solace can be taken in the notion that the proffered disclosure of *Purnadi* is not relevant to the pending claims, as outlined in greater detail below.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup> In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."<sup>2</sup> In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the

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<sup>1</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. §2131.

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); M.P.E.P. §2131 (*emphasis added*).

inherency of that result or characteristic.”<sup>3</sup> Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.<sup>4</sup>

Using the preceding well-settled jurisprudence, it is clear that *Purnadi* fails to anticipate Independent Claim 1. For example, Independent Claim 1 recites a method for selecting a wireless serving node that includes receiving a wireless registration request at a wireless serving node; determining whether the serving node is managing a wireless session associated with the registration request; generating a wireless session inquiry for a group of associated wireless serving nodes if the serving node is not managing a wireless session associated with the registration request...determining the time elapsed since generating the wireless session inquiry; and initiating the establishment of a wireless session if a predetermined amount of time has elapsed. Nothing in *Purnadi* provides such a disclosure.

At the portion cited by the Examiner for this teaching, *Purnadi* provides: “Upon receiving the RA\_ID Update message, the WGW forwards the delayed MIP Registration Reply message to the MS (Step 15). ***Upon expiration of the lifetime, the old WGW sends the All Registration Update message to begin to close the A10 connection (Step 16).*** The old BSC/PCF responds with an A11 Registration Acknowledge message (Step 17) and sends the A11 Registration Request message (with lifetime=0) to the old WGW with accounting related data (Step 18). The old WGW stores the accounting related data and sends an All Registration Reply message (Step 19). The old BSC/PCF closes the A10 connection for the mobile station.” (See *Purnadi* at paragraph 65.)

In the context of anticipation, a simple recitation of a “lifetime” from *Purnadi* does not provide the requisite “determining the time elapsed since generating the wireless session inquiry; and initiating the establishment of a wireless session if a predetermined amount of time has elapsed” of Independent Claim 1. It should be understood that the time elapsed element of Applicant’s pending subject matter is associated with generating a wireless session inquiry, not a random timeout for closing or tearing down a connection. In fact, the

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<sup>3</sup> M.P.E.P. §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

<sup>4</sup> M.P.E.P. §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

time elapsed limitation relates to registration and not to connection cleanup. Additionally, the last portion of Independent Claim 1 co-depends on this time lapse, as what follows is “initiating the establishment of a wireless session if a predetermined amount of time has elapsed.” *Purnadi* could not possibly provide such an element because inherent in this limitation is the prevalence of the elapsed time element, which (as explained supra) is clearly not taught. For at least these reasons, Independent Claim 1 is patentable over *Purnadi*.

Independent Claims 11, 21, 31, 41, 61, 63, and 66 each recite a similar, but not an identical, limitation and, therefore, are also patentable over *Purnadi* for at least this reason. In addition, the dependent claims associated with these Independent Claims are also allowable over *Purnadi* for analogous reasons. Notice to this effect is respectfully requested.

Turning to Independent Claim 51, Independent Claim 51 has been amended to include the limitations of dependent Claim 52. Applicant notes that the Examiner has ostensibly glossed over this claim, as there is no identification from the Examiner as to the specific disclosure from *Purnadi* that would anticipate dependent Claim 52. This is curious indeed, as evaluating the *Purnadi* reference more closely reveals that the elements of dependent Claim 52 are absent from its disclosure.

Independent Claim 51, as amended, recites the steps of “determining whether the registration response contains a wireless serving node identifier if the registration response does not indicate that the registration request is accepted; and generating, if the registration response does not indicate that the registration request is accepted and contains a wireless serving node identifier, a wireless registration request containing the identifier, wherein determining an identifier for a wireless serving node that could potentially service the mobile unit comprises analyzing an identifier of the mobile unit.” Applicant has thoroughly reviewed *Purnadi* and respectfully posits that *Purnadi* fails to offer any disclosure associated with any analysis of an identifier of the mobile unit. For at least this reason, Independent Claim 51 is patentable over this reference.

In addition, Independent Claims 56, 62, and 65 recite a similar limitation and, therefore, are also allowable over *Purnadi* for the same reasons. Additionally, the dependent claims associated with these Independent Claims are also allowable over *Purnadi* using analogous reasoning.

Section 103 Rejection

The Examiner rejects Claims 8, 18, 28, 37, and 47 under 35 U.S.C. §103(a), as being unpatentable over *Purnadi*. This rejection is respectfully traversed for the following reasons. As a preliminary matter, Applicant notes that this rejection is now moot in view the arguments presented supra. This is because to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations. See M.P.E.P. §2142-43. The pending claims are patentable over *Purnadi* for at least the reason that the third prong of non-obviousness has failed, as evaluated thoroughly in the §102-analysis presented above.

With respect to the first prong, nothing in *Purnadi* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.<sup>5</sup> This is because the reference fails to include the above-identified functionality and, therefore, is precluded from rendering the pending claims unpatentable. Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under M.P.E.P.<sup>6</sup> guidelines and governing Federal Circuit case law.<sup>7</sup> The M.P.E.P. consistently

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<sup>5</sup> If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

<sup>6</sup> See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

<sup>7</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary

confirms that this approach is improper and, thus, it should not be used here.<sup>8</sup> Moreover, under the M.P.E.P., such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”<sup>9</sup> Under such circumstances, the Examiner must point to some concrete evidence in the record in support of the rejection, rather than relying on an assessment of what is “well recognized” or what a skilled artisan would be “well aware.”<sup>10</sup>

In the context of the second criterion of non-obviousness, the Examiner has also failed to show any potential interoperability between the system of *Purnadi* and the identified elements that form the proposed combination: much less a reasonable expectation of success for the proposed combinations, as is required. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a prima facie case of obviousness. Therefore, the Examiner has not satisfied any of the criteria that is required to support a proper §103 rejection.

All of the pending claims have been shown to be allowable over the references of record. Written notice to this effect is respectfully requested from the Examiner in the form of a full allowance of the pending claims.

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skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

<sup>8</sup> See M.P.E.P. §2145.

<sup>9</sup> See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

<sup>10</sup> See *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

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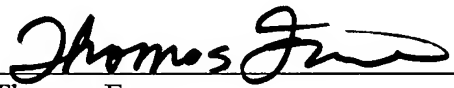
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes that no fees are due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,  
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Attorneys for Applicant

  
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Date: April 11<sup>th</sup>, 2005

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